

### REMARKS

Claims 9-16 are pending in the present application. None of the claims were amended in this response.

Claims 9-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Holmstrom et al.* (WO 98/30053) in view of *Iwata et al.* (US Patent 6,009,338). Applicants traverse the rejection. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not disclose “each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry” as recited in claim 9.

Claim 9 recites a mobile phone including a non-volatile memory in addition to the SIM card. The non-volatile memory comprises at least one data base, wherein each of the at least one data base is respectively assigned to one of the telephone directories in the SIM card or to a further telephone directory in a non-volatile memory. Furthermore, by structuring the directories this way, each entry of a telephone directory is assigned to a corresponding data base entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry. Thus, it is possible to improve the format of the number of attributes which has been previously prescribed by the SIM card. *Holmstrom* does not teach an electronic data base assigned to the telephone directory in the SIM card in order to expand the prescribed structure of the telephone directory in the SIM card with respect to the structure of the telephone directory entries.

Similarly, *Iwata* provides a mobile phone providing an address book (col. 14, line 4 – col. 15, line 13; FIGs. 6 and 7). *Iwata* teaches in FIG. 6 that the mobile phone provides the user with a list of names for an overview of certain address book entries according to a chosen index, wherein by double touching one of the list entries a corresponding address to this entry is scrolled and displayed (see FIG. 7). However, *Iwata* does not disclose the use of SIM cards, and further discloses that lists are stored within RAM memory 25 (col. 13, lines 19-21; col. 18, lines 9-20; FIG. 30 – col. 26, lines 29-48). As such, the reference does not disclose at least one data

base stored in a non-volatile memory, wherein the at least one database is assigned to one specific electronic telephone directory to expand the telephone book structure.

Additionally, Applicant maintains that there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine *Holmstrom* with *Iwata* in the manner suggested in the Office Action. The Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). In making this determination, the question is not whether the differences between the prior art and the claims themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983)(emphasis added). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).


Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

The disclosure in *Holmstrom* is directed to a mobile communication unit, where the phone book is adapted to enable selection of more than one item stored in the phone book and to enable selection of an operation in the phone book to be executed on all items selected. *Iwata* discloses mobile information terminal equipment which also functions as an electronic note, word processor, or personal computer, where the address book is integrates into a RAM memory of a PDA-type architecture. There is no teaching, suggestion or motivation for one having ordinary skill in the art to rely on the PDA/RAM architecture of *Iwata*'s address book to combine with the teaching of *Holmstrom*.. *Holmstrom* explicitly relies on the EEPROM/SIM card architecture to provide the disclosed advantages in the document; in order to incorporate the teaching of *Iwata*, the device disclosed in *Holmstrom* would need to entirely restructure to accommodate the features of *Iwata*.

In light of the above remarks, Applicant respectfully submit that claims 9-16 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-372.

Respectfully submitted,

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